

REMARKS/ARGUMENTS

Amendments

1. In reviewing the claims, Applicant notes that claim 10 was inadvertently marked as "(Withdrawn)" in the April 3, 2006 Response. The Examiner did not catch this mistake. Applicant has relabeled the claim as "(Original)" in this Response. If the Examiner disagrees that this is the appropriate way of handling this matter, Applicant will gladly re-add the subject matter of claim 10 as a "(New)" claim.

2. In reviewing the claims, Applicant notes that claim 8 is a substantial duplicate of claim 2; claim 9 is a substantial duplicate of claim 3; and claim 10 would have been a substantial duplicate of claim 4 (now incorporated in claim 1 and cancelled), leading Applicant to believe that claims 8, 9 and 10 should have originally depended from claim 5, not claim 1. As such, Applicant has amended said claims to depend more properly from claim 5.

3. Claims 1 and 5 have been amended to include the limitation that the:

...pressure sensitive adhesive positioned and configured to allow said fastening side of said pressure sensitive adhesive to be selectively adhered to said lengthwise strip of fabric substantially along said second lengthwise edge so that said first and second lengthwise edges overlap one another and are aligned generally parallel to one another to thereby form a tubular configuration for enveloping the linear object...

Support for that limitation can be clearly found in the drawings, for instance Figures 5 and 6.

4. Such changes add no new matter.

Standards for Patentability

5. "An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner's duty (acting through

the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct." *In re Oetiker*, 977 F.2d 1443, 1449, 24 USPQ2d 1443, 1447, 24 USPQ2d at 1447 (Fed. Cir. 1992) (Judge Plager concurring). "The precise language of 35 USC 102 that 'a person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173 (CCPA 1967), cert. denied, 389 U.S. 1057, reh'g denied, 390 U.S. 1000 (1968).

Claim Rejections - 35 USC § 102

6. The Examiner rejected claims 1-3 and 5-9 under §102(b) as being anticipated by Blackburn (USPN 5,190,533). When Applicant refers to "Blackburn" herein, Applicant is only referring to the portion(s) of Blackburn actually cited by the Examiner.

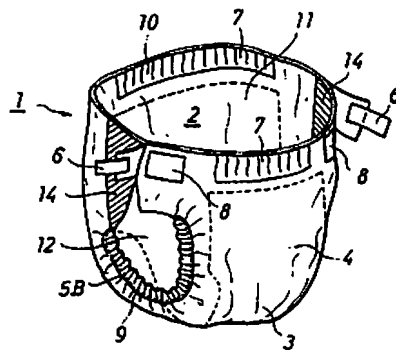
7. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.

8. Claims 1 and 5 both contain the following element not shown in Blackburn, namely that the:

...pressure sensitive adhesive positioned and configured to allow said fastening side of said pressure sensitive adhesive to be selectively adhered to said lengthwise strip of fabric substantially along said second lengthwise edge so that said first and second lengthwise edges overlap one another and are aligned generally parallel to one another to thereby form a tubular configuration for enveloping the linear object, said tubular configuration having a first open end formed along said first widthwise edge and a second open end formed along said second widthwise edge.

Emphasis added. It is thusly that the claimed embodiment's tubular configuration is created.

9. Blackburn doesn't show such a tubular configuration. Blackburn is referring to a prior art disposable diaper. While the two patents mentioned by number in Blackburn in discussion of "prior art" don't show what an assembled disposable diaper looks like, U.S. Patent Number 5,370,634, for sake of discussion, does:



10. In a disposable diaper, what the Examiner argues is the lengthwise edges are brought back together upon themselves to form leg holes. The two widthwise edges come together to form the waistband.

11. Such a configuration does not result in a cylinder/tubular structure, nor does it result in a structure whereby the first and second lengthwise edges overlap one another, nor does it result in a structure whereby the first and second lengthwise edges are aligned generally parallel to one another.

12. Further, to constitute an anticipatory reference, the prior art must contain an enabling disclosure. *Chester v. Miller*, 906 F.2d at 1576 n.2, 15 U.S.P.Q.2d at 1336 n.2 (Fed. Cir. 1990); see also *Titanium Metals Corp. of America v. Banner*, 778 F.2d at 781, 227 U.S.P.Q. at 778 (Fed. Cir. 1985).

- a. A reference contains an enabling disclosure if a person of ordinary skill could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself, and thereby the public, in possession of the invention. *In re Donohue*, 766 F.2d

531, 533, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985); *In re Sheppard*, 339 F.2d 238, 242, 144 U.S.P.Q. 42, 45 (C.C.P.A. 1964).

- b. Blackburn does not contain an enabling disclosure because a person having ordinary skill in the art would have never combined Blackburn's disclosure of disposable diapers with his own knowledge of the art to place himself in possession with the present invention, namely a cord cover.
- 1) A disposable diaper [Blackburn] couldn't even be used as a cord cover. For one thing, it isn't the right shape, namely tubular.
 - 2) Use of a disposable diaper as a cord cover would be unsightly and thus one skilled in the art would have never considered it.
 - 3) Use of a disposable diaper as a cord cover is an inherently disgusting concept and thus one skilled in the art would have never considered it.
 - 4) Disposable diapers are not even in a related art. Thus, Blackburn's disclosure taken with knowledge of the art would never arrive at the present invention's cord cover.

13. Claims 1 and 5, and the claims that depend there-from (claims 2-3, 6-10) are thus not anticipated, the §102(b) rejection should be withdrawn and the application passed on for allowance.

Claim 20

14. New claim 20 has been added. Claim 20 is based upon claim 1 (as amended), but includes the limitation that the lengthwise strip of fabric be generally rectangular, as is shown in the drawings. Such change adds no new matter.

Conclusion

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below. Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 5th day of March, 2007.

Very respectfully,



STEPHEN M. NIPPER

Reg. No. 46,260

(208) 345-1122